UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/939,789	08/28/2001	Eiji Ueda	50023-148	2857

7590 11/15/2006	EXAMINER	
MCDERMOTT, WILL & EMERY	WILDER, PETER C	
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Washington, DC 20005-3096	ART UNIT	PAPER NUMBER
	2623	

DATE MAILED: 11/15/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

	Application No.	Applicant(s)	-
Office Action Summary	09/939,789	UEDA, EIJI	
	Examiner	Art Unit	
	Peter C. Wilder	2623	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on <u>07 August 2006</u>.

2a) ☐ This action is **FINAL.**   2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) <u>1-3,5-7 and 10-13</u> is/are pending in the application.

　　4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) <u>1-3,5-7 and 10-13</u> is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☒ The drawing(s) filed on <u>28 August 2001</u> is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.

　　Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

　　Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

　　a) ☐ All   b) ☐ Some * c) ☐ None of:

　　　1. ☐ Certified copies of the priority documents have been received.

　　　2. ☐ Certified copies of the priority documents have been received in Application No. _____.

　　　3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

　　* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
　　Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413)
　　Paper No(s)/Mail Date. _____.

5) ☐ Notice of Informal Patent Application

6) ☐ Other: _____.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set

forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this

application is eligible for continued examination under 37 CFR 1.114, and the fee set

forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action

has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on

8/7/2006 has been entered.

Response to Arguments

Applicant's arguments filed on 8/7/2006 to claims 1, 2, 5, 7, and 10-13 have been

fully considered but they are not persuasive.

The applicant argues on page 9 "... Kikinis does not disclose selecting a plurality

of content deciding data sequentially in the order indicated by the scenario data,

and accessing contents sequentially based on the content deciding data

selected. Accordingly, Kikinis cannot display contents according to the scenario

data, and thus, cannot guide a viewer to contents according to intention of a

creator of the contents."

The examiner notes in Column 9 lines 24-36 of Kikinis a tag or scenario

data relates a Url/content deciding data to images. When the Url information is

downloaded ahead of time the tag determines the sequential order the

information is retrieved from the cache to be displayed on the screen.

Applicant's arguments with respect to claims 3 and 6 on page 10 have been

considered but are moot in view of the new ground(s) of rejection.

Claim Objections

Claim 2 is objected to because of the following informalities:

The last line in claim two reads "the data communication unit accesses to the

contents based...".

The examiner believes the word "to" should be removed so the claim would read

"the data communication unit accesses the content...."

Appropriate correction is required.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of
matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the
conditions and requirements of this title.

Claim 10 is rejected under 35 U.S.C. 101 because the claimed invention is

directed to non-statutory subject matter.

Claim 10 defines computer program embodying functional descriptive material.

However, the claim does not define a computer-readable medium or memory and is

thus non-statutory for that reason (i.e., "When functional descriptive material is recorded

on some computer-readable medium it becomes structurally and functionally

interrelated to the medium and will be statutory in most cases since use of technology

permits the function of the descriptive material to be realized"). The examiner suggests

amending the claim to embody the program on "computer-readable medium" or

equivalent in order to make the claim statutory.   Any amendment to the claim should be

commensurate with its corresponding disclosure.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of
> making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the
> art to which it pertains, or with which it is most nearly connected, to make and use the same and shall
> set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 12 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply

with the written description requirement. The claim(s) contains subject matter which

was not described in the specification in such a way as to reasonably convey to one

skilled in the relevant art that the inventor(s), at the time the application was filed, had

possession of the claimed invention.

The specification and drawings fail to support "a data sending unit operable to

send the content deciding data and the scenario data demultiplexed by the

demultiplexing unit, and" now recited in claim 12 lines 14-15.

The examiner believes claim 12 relates to Embodiment 4 pages 32-35 and the

examiner cannot find support for the first device sending the scenario data

demultiplexed by the demultiplexing unit.

Claim 10 is also rejected under 35 U.S.C. 112, second paragraph which contains

two separate and distinct requirements (A) that the claim(s) set forth the subject matter

applicants regard as the invention and (B) that the claim(s) particularly point out and

distinctly claim the invention.

The specification does not teach or suggest any program product. It is not clear

what the program product is.

Claim Rejections - 35 USC § 102

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-3, 5-7, 10, 11, and 13 are rejected under 35 U.S.C. 102(e) as being

anticipated by Kikinis (U.S. 5929849).

Referring to claim 1, Kikinis teaches a receiving device (Figure 1 element 11)

receiving broadcasting programs, comprising:

a broadcasting receiving unit operable to receive broadcasting data in which a

plurality of content deciding data deciding positions of contents placed on a network is

multiplexed with a scenario data indicating the order of using the content deciding data

and a broadcasting program associated with said content (Figure 1 element 11 and

Column 5 lines 34-41; Column 7 lines 10-28 teach content deciding data/URL

information is multiplexed in a data stream with scenario data/frames 63 and 67 in

Figure 2B, the data frames teach which URLs are associated with which frames and the

location information in the frame of the URLs);

a demultiplexing unit (Figure 1 elements 13 and 25) operable to demultiplex the

plurality of content deciding data, the scenario data, and the broadcasting program from

the broadcasting data received by the broadcasting receiving unit (The MPEG decoder

25 and the decoder tuner element 13 and Column 5 lines 41-55 and Column 7 lines 47-

56);

a data management unit operable to select all the plurality of content deciding

data demultiplexed by the demultiplexing unit sequentially in the order indicated by the

scenario data demultiplexed by the demultiplexing unit (Column 7 lines 10-27 teach

each frame having associated data region/scenario data with the image position and the

associated URL, the order in which the enhanced data is displayed and/or accessed is

related to the frames which enable the enhanced data to be selected; Also Column 9

lines 24-53 teaches transmitting URL information ahead of time and having a tag or

scenario data linking the URLs to the frames); and

a data communication unit operable to access all the contents sequentially based

on the content deciding data selected by the data management unit (Column 7 lines 10-

17, Figure 2C, Column 8 lines 1-37 all teach a user being able to sequentially access

the related web-pages while watching a program with embedded links; Column 9 lines

24-67 teaches the device sequentially allowing a user to access webpages based on

the chosen URL/content deciding data by the user by using a network interface unit

(NIM)).

Referring to claim 2, depending on claim 1, Kikinis teaches wherein the

demultiplexing unit (Figure 1 elements 13 and 25) demulitplexes the plurality of content

deciding data respectively from the broadcasting data when there is the plurality of the

content deciding data in the broadcasting data (Figure 1, MPEG decoder 25 and

decoder tuner 13 Figure 1; Column 5 lines 34-55 teach different entities associated with

different URLs or different data locations'; Column 7 lines 10-17 and lines 47-56),

the data management unit is operable to select one and more content deciding

data from the plurality of content deciding data demultiplexed by the demultilplexing unit

according to a specific condition (Column 7 lines 10-17 teaches a specific condition

occurring where the user selection causes a content deciding data/URL representing a

webpage to be retrieved), and

the data communication unit accesses to the contents based on the content

deciding data selected by the data management unit (Column 7 lines 10-17 direct the

user to the WEB).

Referring to claim 3, depending on claim 2, Kikinis teaches the data

management unit selects the content deciding data corresponding to an audio language

outputted by the receiving device form the plurality of content deciding data

demultiplexed by the demultiplexing unit (Column 3 lines 54-60 and Column 7 lines 10-17 teach multiple URLs can be associated to a specific entity image and the data management unit/CPU would select a webpage/URL based on the user control; Column 7 lines 56-67 teaches retrieving a webpage; thus with someone watching Television in the United States there is a high likely hood that English language is coming out of the audio system, Also there is high likely hood that the webpage retrieved has English words on it so there is correspondence between the audio out and the retrieved webpage;   Also, in Figure 2A and Column 6 lines 50-63 it talks about the car in the advertisement being a specific brand of car thus the audio for the advertisement would relate to the brand of car and Column 7 lines 1-17 teaches retrieving a URL which relates to the advertisement thus the audio output and the URL correspond to one another), and

the data communication unit accesses the content according to the content deciding data selected by the data management unit (Column 5 lines 55-67 teach a modem/data communication unit and Column 7 lines 10-67).

Referring to claim 5, depending on claim 1, Kikinis teaches the content deciding data deciding a position of content placed on the network is a uniform resource locator (URL) ('each fram has an associated data region with the image position and extent data, and the associated URL' Column 7 lines 10-28; Column 5 lines 34-41).

Referring to claim 6, depending on claim 1, Kikinis teaches the content deciding data deciding positions of contents placed on the network is a group of keywords (Column 7 lines 10-17 teaches the use of URLs and according to Newton's Telecom Dictionary page 880 the definition of URL represents keywords such as harrynewton which also can be represented as 209.94.129.207).

Referring to claim 7, see the rejection of claim 1.

Referring to claim 10, see the rejection of claim 1 (Figure 1 element 19 and Column 5 lines 34-48 teach a CPU which inherently requires a computer program to function).

Referring to claim 11, see the rejection of claim 1 and Kikinis teaches the use of storage mediums ROM 47, DRAM 48, which are used by CPU 19 in Figure 1.

Referring to claim 13, depending on claim 1, Kikinis teaches wherein the scenario data includes data indication the display order of the plurality of contents corresponding to the plurality of contents data, and data indication a time for displaying content (time is defined as 'the point or period when something occurs'; each frame has an associated data region with the image position and the associated URL; since each frame has associated URLs, the order in which the enhanced data is displayed and/or accessed is related to the frames which enable the enhanced data to be selected.

Therefore, the point or period in which the enhanced data is displayed is indicated;

Column 7 lines 10-27; Column 5 lines 42-48 teach the use of MPEG II which includes

time stamp information in the signal).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

Claims 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kikinis

(U.S. 5929849) in view of Allport (U.S. 6567984 B1).

Referring to claim 12, see the rejection of claim 1 and

the first receiving device (element 11 in Figure 1 the set-top box) and a second

receiving device (Sever 54 connected to link 37 described in Column 6 lines 1-13).

A data sending unit operable to send the content deciding data demultiplexed by

the demultiplexing unit (Column 6 lines 1-13 teaches the first device sending the URL to

the web server), and

Wherein the second receiving device comprises:

A data·sending-receiving unit operable to access all the contents sequencially

based on the content deciding data received from the data sending unit (Column 6 lines

1-13 teach a server which is a send-receiving unit receiving URL information from the

first device; Column 7 lines 10-56 teaches the webpages are accessed in the order that

the user wishes to receive the information so the URLs are received at the server

sequentially).

Kikinis fails to teach a data sending unit operable to send the scenario data

demultiplexed by the demultiplexing unit.

In an analogous art Allport teaches a data sending unit operable to send the

scenario data demultiplexed by the demultiplexing unit (Column 9 lines 11-19 and

Figure 3 teaches a data sending unit and Column 13 lines 15-45 teaches encoding the

signals in MPEG for transmission to the wireless remote 10 and MPEG which requires a

presentation time stamp/scenario data to be part of the data so the decoder knows

when to decode and present the image).

At the time the invention was made it would have been obvious for one skilled in

the art to modify the URL embedding system of Kikinis using the scenario data sending

system of Allport for the purpose of allowing the user to display TV programs on the

remote controls display and thus being able to make sure the MPEG is decoded

properly thus displaying the television images in the correct order.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Peter C. Wilder whose telephone number is 571-272-2826. The examiner can normally be reached on 8 AM - 4PM Monday - Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chris Grant can be reached on (571)272-7294. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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